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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,140	01/29/2002	Takafumi Taguchi	1403-0223P	7690
2292	7590	03/25/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			KNABLE, GEOFFREY L	
PO BOX 747			ART UNIT	
FALLS CHURCH, VA 22040-0747			PAPER NUMBER	

1733

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,140

Applicant(s)

TAGUCHI ET AL.

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 12-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3,5 and 12-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the last office action, the claim 1 definition of the second rubber composition using the normally closed language "consisting of" followed by a list of components was considered to raise an ambiguity in the scope of the claim in light of the previous presentation of dependent claims 8-10 that also defined that the second rubber composition contained other materials beyond those mentioned in claim 1 (thereby appearing to contradict the "closed" language). In response to this rejection, applicant canceled claims 8-10 and urged that any issues raised thereby were obviated by their cancellation. However, since the claim 1 definition for the second rubber composition now also does not even read on the exemplary composition described in the specification for this layer, clarification/confirmation is still considered to be required for the record that this is the intended reading of the scope of this claim, i.e. that the rubber composition of this second rubber layer can only include the specific components listed and no others – i.e. this language would not just exclude silica but also any other material including components that are present in the example in the specification.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-3, 5 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koch et al. (US 3,038,515) taken with the excerpted Exxon technical article, Gessler et al. (US 4,014,852) and (optionally) GB 2,072,576 to Exxon (Hous et al.).

These references are applied for the same reasons as set forth in the last office action. New claims 13-17 correspond to claims previously presented and the references are therefore applied against these claims for the same reasons applied against the analogous claims in the last office action. To the extent that claims 1-3 and 5 are to be read as excluding well known common minor vulcanizing, processing, etc. ingredients, it is considered to have been within the skill of the artisan to either include or exclude such well known and typical ingredients for only the expected results on processing and vulcanization properties of the composition, the influence of such well known vulcanizing and processing ingredients being extremely well known and well understood in this art.

5. Claims 1-3, 5 and 12-17 are rejected under 35 U.S.C. 103 as being unpatentable over Koch et al. (US 3,038,515) taken with Berta (US 4,616,686) and Berta (US 4,587,302).

These references are applied for the same reasons as set forth in the last office action. New claims 13-17 correspond to claims previously presented and the references are therefore applied against these claims for the same reasons applied against the analogous claims in the last office action. As above, to the extent that claims 1-3 and 5 are to be read as excluding well known common minor vulcanizing,

processing, etc. ingredients, it is considered to have been within the skill of the artisan to either include or exclude such well known and typical ingredients for only the expected results on processing and vulcanization properties of the composition, the influence of such well known vulcanizing and processing ingredients being extremely well known and well understood in this art.

6. Applicant's arguments filed 12-21-2004 have been fully considered but they are not persuasive.

The previous 35 USC 112, first paragraph rejection has been withdrawn in light of applicant's response. The 35 USC 112, second paragraph rejection has however been maintained to the extent noted in the statement of rejection above.

As to the prior art rejections, it is argued that silica is essential to the Koch et al. invention and that the "present invention" excludes the use of silica. However, the claims only exclude silica from the second rubber composition and thus it is not for example excluded from the butyl rubber layer. Further, it is again considered that Koch et al. contemplates that the silica need only be added to "one of the rubbery components of the laminate" (col. 1, lines 26-30) or by "incorporating silica in one of the layers" (col. 1, lines 36-40). In fact, col. 4, lines 4-11, and particularly the sentence that "[w]hen silica is added to the butyl-type rubber portion, the steps of mixing the compounds and vulcanizing may be carried out as described with the same improved adhesion," would indicate to the artisan that the silica can be used in the butyl rubber layer *instead of* the GRS layer and yield the same improved adhesion. Applicant's argument would seem to be that these lines can only be read to suggest that the silica

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be present in *both* the GRS layer and the butyl layer. However, it seems an unlikely and illogical reading of this, particularly when taken with the col. 1 citations, since there would be little reason to reference "the same improved adhesion" if this was simply saying that the silica also be in the butyl layer. As such, it is still considered that this reference would have been read by the artisan as including teachings of a tire in which the silica need not be added to the GRS layer (i.e. added only to the butyl layer) and as such, bonding of a butyl liner to the carcass using a GRS layer without silica is disclosed or certainly obvious from these teachings.

It is also argued that even if Koch et al. only suggests that silica can only be in the innerliner, the claims exclude the presence of natural rubber in the innerliner layer. However, as noted in the 3-24-2004 office action, the Board of Appeals has determined that the prior art "teachings would have reasonably suggested to one of ordinary skill in this art that the blend of natural rubber and chlorobutyl rubber in the compounding composition for the inner liner of Koch Example II can be replaced with a blend of regular butyl and bromo- or chlorobutyl rubber..." (first full paragraph from page 11 of the decision by the Board of Appeals). As such, providing a composition for the inner liner that only includes the regular and halobutyl was determined by the Board of Appeals to have been taught.

As to the curing system and the reference teachings relevant thereto, the comments made in the statement of rejection in the 3-24-2004 office action, and the Board of Appeals affirmance thereof, amply address this issue.

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7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
March 20, 2005